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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,798	12/12/2003	Rema Ananthanarayanan	JP920030082US1	3886

29154   7590   01/19/2010
FREDERICK W. GIBB, III
Gibb Intellectual Property Law Firm, LLC
2568-A RIVA ROAD
SUITE 304
ANNAPOLIS, MD 21401

EXAMINER
VEZERIS, JAMES A

ART UNIT	PAPER NUMBER
3693	

MAIL DATE	DELIVERY MODE
01/19/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

		Application No.	Applicant(s)
Office Action Summary		10/734,798	ANANTHANARAYANAN ET AL.
		Examiner	Art Unit	
		JAMES A. VEZERIS	3693	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>29 September 2009</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-4, 6-10, 12-14, and 17</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-4, 6-10, 12-14, and 17</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a) ☐ All   b) ☐ Some *   c) ☐ None of:

         1. ☐ Certified copies of the priority documents have been received.

         2. ☐ Certified copies of the priority documents have been received in Application No. _____.

         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 08-06)   **Office Action Summary**   Part of Paper No./Mail Date 20100111

Final Rejection

1.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

    A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Pre-Exam Formalities

2.   Claim 7 has been amended.

3.   Claims 1-4, 6-10, 12-14, and 17 are currently pending.

Response to Applicant's Arguments

4.   Applicant's arguments, see Page 1, filed 9/29/2009, with respect to claims 7-10

being rejected under 35 U.S.C. 112 1st paragraphs have been fully considered and are

persuasive. The rejection of claims 7-10 has been withdrawn.

5.   Applicant's arguments filed 9/29/2009 have been fully considered but they are

not persuasive. Applicant argues: "...Preist fails to disclose, teach or even suggest at

least the features directed to: 1) using said computer to invoke standalone bilateral negotiations, which stand apart from the multi-party trading mechanism, to arrive at customized trading offers, the standalone bilateral negotiations being invoked with the trading parties who submitted trading offers, as recited in independent claim 1 and similarly recited in independent claim 7 and 12; and 2) using said computer to invoke standalone bilateral negotiations, which stand apart from the multi-party trading mechanism, to arrive at customized trading offers, the standalone bilateral negotiations being invoked with the trading parties who submitted trading offers, said invoking further comprising: agreeing upon a protocol for conducting the standalone negotiations; exchanging offers as per the agreed upon protocol; and concluding the standalone negotiations as per the agreed upon protocol, as recited in independent claim 6 and similarly recited in independent claim 17." More concisely, applicant argues Paragraph 62 of Priest, used by the Examiner to reject the limitation of "using said computer to invoke standalone bilateral negotiations, which stand apart from the multi-party trading mechanism, to arrive at customized trading offers, the standalone bilateral negotiations being invoked with the trading parties who submitted trading offer, found in some form in independent claims 1, 7, 12, and 17, fails to teach the limitation. Applicant contends that Priest fails to show the trading parties "switch" or "invoke standalone bilateral negotiations, which stand apart from the multi-party trading mechanism."

6.   Examiner disagrees with applicant's argument and contends that the applicant has failed to differentiate the pending application from US PG-Pub 2002/0120588 to Priest et al. Applicant claim states, "using said computer to invoke standalone bilateral

negotiations, which stand apart from the multi-party trading mechanism, to arrive at

customized trading offers, the standalone bilateral negotiations being invoked with the

trading parties who submitted trading offer" Examiner specifically points to paragraph 62

of Priest to cover all of the limitations. After initial offers are made the negotiation host of

Priest reviews all offers. When it is determined the negotiation host acts as an

agreement maker. It creates agreement by taking offers from the selected buyers and

sellers and applying rules (which create a form of negotiation) to create a deal. As can

be seen in the art the negotiation occurs after two series of validations. These

validations remove other parties resulting in a stand alone negotiation amongst the

bidders and sellers whom were validated.

Claim Rejections- 35 U.S.C. 102(e)

8.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

Claims 1-4, 6, 7, 9, 10, 12-14, and 17 rejected under 35 U.S.C. 102(e) as being

anticipated by US PG-Pub 2002/0120588 A1 to Preist et al. (Hereinafter "Preist")

Regarding Claims 1, 6, 7, 12, and 17.

        Preist teaches a computer-implemented method of trading in an online market,

the online market comprising a user and a plurality of trading parties, the method

comprising:

using a computer to specify, by a user, initial requirements for initiating trading

among trading parties in said online market;

using said computer to execute a multi-party trading mechanism to arrive at

trading offers, the trading offers being submitted by the trading parties based on the

initial requirements of the user;

wherein the multi-party trading mechanism comprises one of a continuous

double auction, a call market, an ascending price auction, a descending price auction, a

first price sealed bid auction, a uniform second price auction, and a reverse auction

conducted by the user and the trading parties;

using said computer to select a first trading offer from the trading offers of said

multi-party trading mechanism;

using said computer to invoke standalone bilateral negotiations, which stand

apart from the multi-party trading mechanism, to arrive at customized trading offers, the

standalone bilateral negotiations being invoked with the trading parties who submitted

trading offers, said invoking further comprising:

agreeing upon a protocol for conducting the standalone negotiations;

exchanging offers as per the agreed upon protocol; and

concluding the standalone negotiations as per the agreed upon protocol;

using said computer to repeat said executing of said multi-party trading

mechanism, and either said selecting of said trading offers of said multi-party trading

mechanism or said invoking said standalone bilateral negotiations to obtain either attractive and feasible trading offers from the multi-party trading mechanism or said customized trading offers from the standalone bilateral negotiations, respectively;

using said computer to evaluate the attractive and feasible offers from the multi-party trading mechanism or the customized trading offers from the standalone bilateral negotiations by any of a utility function based on multiple attributes of a traded good or a traded service, a user-specified weights associated with the traded good or the traded service, and a user-specified costs associated with the multiple attributes of the traded good or the traded service; and

using said computer concluding trading deals based on evaluated attractive and feasible offers from the multi-party trading mechanism or the customized trading offers from the standalone bilateral negotiations, whereby said multi-party trading mechanism and said standalone bilateral negotiations are combined.

(See Preist Paragraphs 55-63)

Regarding Claims 2, 9, and 13.

Preist further teaches the invoking the standalone bilateral negotiations comprises:

agreeing upon a protocol for conducting the standalone negotiations;

exchanging offers as per the agreed upon protocol; and

concluding the standalone negotiations as per the agreed upon protocol. (See Preist Paragraphs 55-63)

Regarding Claims 3, 10, and 14.

Preist further teaches the exchanging offers comprises:

receiving offers from the trading parties;

evaluating the received offers;

generating counter-offers on a basis of evaluated offers;

sending counter-offers to the trading parties; and

repeating said receiving, said evaluating, said generating and said sending in

accordance with the agreed upon protocol. (See Preist Paragraphs 55-63)

Regarding Claim 4.

Preist further teaches the online market is a regulated online market, the online

market being regulated to increase trading efficiency of the online market, the trading

efficiency of the online market being governed by a number of trading parties that strike

a trading deal. (Paragraphs 6 an 7)

Claim Rejections- 35 U.S.C. 103(a)

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

10.   The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

11.   Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Preist in view of US PG-Pub 2001/0032175 A1 to Holden et al. (Hereinafter "Holden").

Regarding Claim 8.

Preist teaches executing a trading mechanism further comprises:

a repository containing information related to the initial requirements of trading parties; (See Preist Paragraphs 55-63)

Priest fails to teach a repository containing information related to past trading deals; and

a repository containing information related to the trading parties.

Holden teaches:

a repository containing information related to past trading deals; (See Holden Claim 14)

a repository containing information related to the trading parties. (See Holden Paragraph 37)

It would be obvious to one skilled in the art to combine Holden and Preist.

There is motivation to do so because Preist relies on past trading deals and information relating to the parties which can be provided by Holden allowing Preist to make more accurate, and efficient negotiations.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES A. VEZERIS whose telephone number is (571)270-1580. The examiner can normally be reached on Monday-alt. Fridays 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/   /JAMES A VEZERIS/
Supervisory Patent Examiner, Art Unit 3693   Examiner, Art Unit 3693

1/12/2010